

## REMARKS

The Examiner rejected claim 16 under 35 U. S. C. § 112, second paragraph. The Examiner identified certain instances of perceived indefiniteness in claim 16. By this amendment, a good faith effort has been made to overcome these specifically identified instances of perceived indefiniteness. Accordingly, Applicant submits that this rejection is overcome. An instance of indefiniteness was also identified in claim 14, and that instance has been dealt with by this amendment.

The Examiner rejected claims 12 and 18 under 35 U.S.C. § 102. The Examiner relied upon Kahmann et al. DE 198 16 041 (hereinafter Kahmann) to support this rejection. The Examiner relies upon Kahmann's elements 10, 10', 10'' to teach multiple sections, elements 12, 14 to teach the first and second passageways, elements 21, 22 to teach a valve coupled to the first passageway permitting fluid that flows through the first passageway 12 to be provided to the second passageway 14 upon actuation of the valve 21 or 22 and out of the fluid changer 10, the first passageway 12 adapted to permit the passage of a pig through the first passageway 12 (by reason of the uniformity of the bore forming passage 12 as illustrated in Figs. 2 and 3 of Kahmann, such uniformity being adapted, in the Examiner's view, to permit the passage of a pig therethrough), each section 10, 10', 10'' comprising a separate module (calling Applicant's attention to section 10 in Figs. 2-3), the modules being selectively removably connectable together in a desired number to permit the selection of any desired number of fluids in the fluid changer, all as recited in claim 12. In support of this argument, the Examiner calls Applicant's attention to Kahmann's Fig. 1, three different modules 10, 10', 10'' for three different fluids 5, 5, 5.

Claim 12 is cancelled without prejudice. The rejection of claim 12 is thus moot. Claim 18 has been amended to depend from claim 13, the patentability of which is argued below.

The Examiner rejected claims 5, 6, 7, 9, 11, 13, 14 and 16 under 35 U.S.C. § 103. The Examiner relied upon Kahmann as noted above in connection with the 35 U. S. C. § 102 rejections of claims 12 and 18 to support this rejection.

With respect to claim 5, the Examiner relies upon Kahmann's elements 10, 10', 10'' to teach the claim's separate modules, selectively removably connectable together in a desired number to permit the selection of any of a desired number of fluids in the fluid changer, calling Applicant's attention to Kahmann's Fig. 1.

With respect to claim 11, the Examiner relies upon Kahmann to teach that the

fluid changer comprises a coating material color changer for selecting among a number of colors (three in Kahmann, the Examiner believes) of coating material to be supplied to an output of the color changer.

The Examiner takes the position that Kahmann teaches every element of claims 6, 13 and 14 except two second passageways, each section further including two valves coupled to that section's first passageway, each valve permitting the fluid that flows through that section's first passageway to be provided to a respective one of that section's second passageways upon actuation of that respective valve, and out of the fluid changer. The Examiner concludes that it would have been 35 U. S. C. § 103 obvious to one having ordinary skill in the art at the time the invention was made to include two second passageways, each section further including two valves coupled to that section's first passageway, each valve permitting the fluid that flows through that section's first passageway to be provided to a respective one of that section's second passageways upon actuation of that respective valve, and out of the fluid changer, citing St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

The Examiner takes the position that Kahmann teaches every element of claims 7, 13 and 14 except two circuits for supplying the fluids transported through the two second passageways to two fluid dispensing devices, each valve providing the fluid that flows through its respective one of its respective sections' second passageways upon actuation of that respective valve, and out of the fluid changer to a respective one of the circuits and to a respective dispensing device. The Examiner concludes that it would have been 35 U. S. C. § 103 obvious to one having ordinary skill in the art at the time the invention was made to include two circuits for supplying the fluids transported through the two second passageways to two fluid dispensing devices, each valve providing the fluid that flows through its respective one of its respective sections' second passageways upon actuation of that respective valve, and out of the fluid changer to a respective one of the circuits and to a respective dispensing device, again citing St. Regis Paper Co. v. Bemis Co., *supra*.

The Examiner takes the position that Kahmann teaches every element of claims 9 and 16 except valve means for switching between supplying the fluids transported through the two second passageways to the fluid dispensing device, the valve means providing the fluid that flows through a selected one of the second passageways to the dispensing device. The Examiner concludes that it would have been 35 U. S. C. § 103 obvious to one having ordinary skill in the art at the time the invention was made to include valve means for switching between supplying the fluids transported through the two second

passageways to the fluid dispensing device, the valve means providing the fluid that flows through a selected one of the second passageways to the dispensing device.

Basically, then, the Examiner's argument in each of these 35 U. S. C. § 103 rejections based upon Kahmann can be reduced to the following exceedingly straightforward analysis. First, the differences between the claim under examination and the prior art are determined. Then, the Examiner proceeds directly to the conclusion that these differences would have been 35 U. S. C. § 103 obvious. This analysis certainly facilitates examination. But, of course, this analysis is not what is contemplated by 35 U. S. C. § 103.

Instead, first the elements of a 35 U. S. C. § 103 obvious combination need to be found in the prior art. Then, some motivation must be found in the prior art of record for constructing the multiple section fluid changer of the claims. However, here no motivation is found where motivation must be to make out a *prima facie* case of 35 U. S. C. §103 obviousness. That is, here no motivation is found in the prior art of record. Rather, the only source for the motivation to construct the multiple section fluid changer of Applicant's claims is Applicant's claims themselves. Using the claims as the source for the motivation to construct the claimed multiple section fluid changer does not make out a *prima facie* case of 35 U. S. C. §103 obviousness. Quite the contrary, Applicant submits. It makes out a *prima facie* case of 35 U. S. C. §103 unobviousness. It is well-settled that

The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time . . . That which may be made clear and thus 'obvious' to a court, with the invention fully diagrammed and aided . . . by [experts in the field], may have been a breakthrough of substantial dimension when first unveiled.

Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547-548 (Fed. Cir. 1985). Confer Uniroyal Inc. v. Rudkin-Wiley Corp., 5 USPQ 2d 1434, 1438.

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984)). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references (citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297 n.24, 227 USPQ 657, 667 n.24 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). This it has not

done. The Board points to nothing in the cited references, either alone or in combination, suggesting or teaching Fine's invention." In re Fine, 5 USPQ 2d 1596, 1598-99 (Fed. Cir. 1988).

From its discussion of the prior art it appears to us that the court, guided by the defendants, treated each reference as teaching one or more of the specific components for use in the Feil system, although the Feil system did not then exist. Thus the court reconstructed the Feil system, using the blueprint of the Feil claims. As is well established, this is legal error (citing Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 774, 218 USPQ 781, 791 (Fed. Cir. 1983), *cert. denied*, 104 S.Ct. 1284, 224 USPQ 520 (1984)).

Interconnect Planning, *supra.* at 548.

Here the Examiner clearly has used Applicants' claims as a blueprint for assembling the elements necessary to support his position concerning the 35 U. S. C. §103 obviousness of Applicant's claims. Indeed, the Examiner did not even trouble himself to find the elements in the prior art. He simply quoted Applicant's claim language and concluded that it would have been 35 U. S. C. §103 obvious to construct the claimed system. As the above-quoted cases make clear, that is not the analysis contemplated by 35 U. S. C. §103.

More is required to make out a *prima facie* case of obviousness under 35 U. S. C. § 103. Applicant submits that Kahmann does not meet the requirements recognized by Interconnect Planning to make out a *prima facie* case of 35 U. S. C. § 103 obviousness.

The Examiner relies upon St. Regis Paper to support his analysis. However, Applicant does not believe that St. Regis Paper dictates a 35 U. S. C. § 103 obviousness conclusion. In St. Regis Paper, the question was whether the combination of a first reference which taught a paper bag having (1) gussets, (2) a pinch bottom and (3) three step features at the top and bottom of the bag, with a second reference which taught (4) a paper bag having multiple layers, would have rendered 35 U. S. C. § 103 obvious a claim to a paper bag reciting elements (1)-(4). St. Regis Paper, *supra.*, at 838. St. Regis Paper can thus be clearly distinguished from the present situation since, by the Examiner's own admission in his statement of the reasons for rejection, the prior art does not teach: claims 6, 13 and 14's two second passageways, each section further including two valves coupled to that section's first passageway, each valve permitting the fluid that flows through that section's first passageway to be provided to a respective one of that section's second passageways upon actuation of that respective valve, and out of the fluid changer; or claims 7, 13 and 14's two circuits for supplying the fluids transported through the two second passageways to two fluid dispensing

devices, each valve providing the fluid that flows through its respective one of its respective sections' second passageways upon actuation of that respective valve, and out of the fluid changer to a respective one of the circuits and to a respective dispensing device; or claims 9 and 16's valve means for switching between supplying the fluids transported through the two second passageways to the fluid dispensing device, the valve means providing the fluid that flows through a selected one of the second passageways to the dispensing device.

Additionally, St. Regis Paper was decided in 1977 under the old "synergistic results" test for 35 U. S. C. § 103 obviousness. St. Regis Paper, *supra.*, at 838. "Synergistic results" hasn't survived as a favored test for 35 U. S. C. § 103 obviousness.

A requirement for "synergism" or a "synergistic effect" is nowhere found in the statute, 35 U.S.C. When present, for example in a chemical case, synergism may point toward nonobviousness, but its absence has no place in evaluating the evidence on obviousness. The more objective findings suggested in *Graham* [*v. John Deere Co.*, 383 U. S. 1, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966)], are drawn from the language of the statute and are fully adequate guides for evaluating the evidence relating to compliance with 35 U.S.C. § 103. *Bowser Inc. v. United States*, 388 F. 2d 346, 156 USPQ 406 (Ct. Cl. 1967). (Emphasis Applicant's.)

Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1540, 218 USPQ 871, 880 (Fed. Cir. 1983). See also M. P. E. P. § 2141.

Accordingly, Applicant submits that the 35 U. S. C. § 103 rejection of claims 5, 6, 7, 9, 11, 13, 14 and 16 is overcome.

The Examiner further rejected claims 4, 8, 10, 15 and 17 under 35 U. S. C. § 103. The Examiner relies upon the combination of Kahmann and Kock U. S. Patent 3,674,205 (hereinafter Kock) to support this rejection. The Examiner relies upon Kahmann as noted above. The Examiner relies upon Kock to teach that it is known in the art to employ a pressure regulator, calling Applicant's attention to Kock's DUMP I and DUMP II valves in Kock's Fig. 1, single regulator valve DUMP I, II of Kock's Fig. 2 in the fluid circuit between the fluid changer (MANIFOLD I or MANIFOLD II) and the dispensing device (SPRAY GUN) for the purpose of regulating the fluid pressure supplied to the dispensing device from the fluid changer. The Examiner concludes that it would have been obvious to a person having ordinary skill in the art at the time the invention was made to employ a pressure regulator in the circuit between Kahmann's fluid changer 10, 10', 10'' and dispensing device 15 for the purpose of regulating the fluid pressure supplied to the dispensing device from the fluid changer based upon the teachings of Kock.

The Examiner relied upon Kock solely for its teaching of a fluid pressure regulator. Claims 4, 8, 10, 15 and 17 depend from various ones, or combinations, of claims 5, 6, 7, 9, 11, 13, 14 and 16, the patentability of which is argued above. That argument is incorporated here by reference. Therefore, Kock adds nothing to the teachings of Kahmann regarding the deficiencies of Kahmann noted in that argument. Therefore, claims 4, 8, 10, 15 and 17 are entitled to favorable consideration, culminating in allowance, at least on this basis.

Therefore, Applicant submits that claims 4-11 and 13-18, as presented herein, are in condition for favorable consideration, culminating in allowance. Such action is respectfully requested.

The Commissioner is authorized to charge any fees which may be due in order to constitute this a timely response to the March 12, 2004 official action to Deposit Account 10-0435 with reference to Applicant's undersigned counsel's file 3030-69441.

Respectfully submitted,



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